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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DALE F. MCINTYER and JOHN R. FREDLUND

Appeal 2009-003642
Application 09/891,751
Technology Center 2400

Decided: December 4, 2009

Before LANCE LEONARD BARRY, ST. JOHN COURTENAY III, and
JAMES R. HUGHES, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's rejection of claims 4, 7, 10-12, 21, 22, 29, and 30. Claims 1-3, 5, 6, 8, 9, 13-20, and 23-28 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We affirm.

STATEMENT OF THE CASE

INVENTION

The invention on appeal is directed generally to automatically managing digital image files over a communication network (Spec. 1).

More particularly, Appellants' invention is directed to:

A method, system and software product for managing digital media files for a user. An unique user icon or image content identifier is associated with an unique user that can be used for allowing controlled access by an authorized party to digital media files based on the presence of the icon. The digital image media file can be analyzed for determining if an image content identifier is present. The icon or image identifier allows for . . . automatically forwarding the digital image to an electronic address over the communication storing the image, based on identifying the feature within the image. The icon may also include metadata that is searchable.

(Abstract; Spec. 54).

ILLUSTRATIVE CLAIM

4. A method for automatically forwarding a digital media file by a first party to a second party over a communication network, said digital media file having at least one digital image file comprising the steps of;

automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier, said image content identifier having an associated electronic address of a second party; and

automatically forwarding said digital image from said first party to said electronic address of said second party over said communication network if said image content identifier matches a portion of said image.

PRIOR ART

Davis	US 2002/0001395 A1	Jan. 3, 2002 (filed Apr. 20, 2001)
Capps	US 2002/0111813 A1	Aug. 15, 2002 (filed Feb. 13, 2001)
Lloyd-Jones	US 2002/0055955 A1	May 9, 2002 (filed Apr. 6, 2001)
Goldberg	US 2004/0008872 A1	Jan. 15, 2004 (filed Jul. 8, 2003)

THE REJECTIONS

1. The Examiner rejected claims 4, 7, 10, 12, 21, 22, 29, and 30 under 35 U.S.C. § 103(a) as unpatentable over the combination of Capps, Lloyd-Jones, and Goldberg.
2. The Examiner rejected claim 11 under 35 U.S.C. § 103(a) as unpatentable over the combination of Capps, Lloyd-Jones, Goldberg, and Davis.

GROUPING OF CLAIMS

Based on Appellants' arguments in the Brief, we will decide the appeal on the basis of claims 4 and 11. *See* 37 C.F.R. § 41.37(c)(1)(vii).

APPELLANTS' CONTENTIONS

Combinability under § 103

Appellants contend that the Examiner has improperly combined the references because “Goldberg fails to provide any suggestion to implement or otherwise be combined with an apparatus for annotating an image as described in Lloyd-Jones.” (App. Br. 8). Appellants further contend that “Lloyd-Jones fails to provide any suggestion to implement or otherwise be combined with a system for recognizing a patron’s face as described in Goldberg. (*Id.*).

Limitations under § 103

Regarding the Capps reference, Appellants contend that “Capps fails to teach or suggest at least automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier, said image content identifier having an associated electronic address of a second party as required by Applicants’ independent claims.” (App. Br. 5).

Regarding the secondary Lloyd-Jones reference, Appellants contend that “Lloyd-Jones fails to teach or suggest at least automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier, said image content identifier having an associated electronic address of a second party as required by Applicants’ independent claims.” (App. Br. 7).

Regarding the tertiary Goldberg reference, Appellants contend that “Goldberg fails to remedy the deficiencies of Capps as Goldberg fails to teach or suggest at least automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file

matches an image content identifier, said image content identifier having an associated address of a second party as required by Applicants' independent claims.” (*Id.*).

Regarding dependent claim 11, Appellants contend that “[i]t is submitted that further consideration of claim rejections under 35 USC 103(a) upon the citing of the fourth applied prior art reference to Davis is moot, inasmuch as the combination of Capps, Goldberg, Lloyd-Jones and Davis still lack any teaching, disclosure, or suggestion concerning a content identifier having an associated address of a second party as previously discussed.” (App. Br. 8).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

Issue 1: Have Appellants shown that the Examiner erred in combining the cited references under §103?

Issue 2: Have Appellants shown that the Examiner erred in finding that the combination of Capps, Lloyd-Jones, and Goldberg teaches or would have suggested the argued limitations of automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier, said image content identifier

having an associated electronic address of a second party? (*See* representative claim 4).

PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

Invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent . . . unless more ingenuity and skill were required in making or applying the said improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitute the essential elements of every invention.

Dunbar v. Myers, 94 U.S. 187, 197 (1876) (citing *Hotchkiss v. Greenwood*, 52 U.S. 248, 267 (1850)) (*Hotchkiss v. Greenwood* was cited with approval by the Supreme Court in *KSR*, 550 U.S. at 406, 415, 427).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellants’ Brief to show error in the Examiner’s proffered prima facie case.

FINDINGS OF FACT
Appellants' Specification

1. Appellants disclose:

For example, an image icon 202, such as illustrated in FIG. 10b can be used as a content identifier to first identify content of images forwarded to the service provider 80. In the embodiment illustrated, the image icon 202 is in the form of the face of an individual taken from image 206 of FIG. 10a. Thus face recognition software programs, such as described in copending U.S. pending patent application entitled A METHOD AND SYSTEM FOR CATALOGING IMAGES, of John R. Squilla and Dale Fredrick McIntyre, serial no. 09/640,938, filed August 17, 2000 which is hereby incorporated in its entirety by reference, can be used to review the images to be forwarded and identify the images with such content identifiers. When such images are identified, the identification information is recorded as metadata and stored in association with that image. The identification information can be used to identify who can view this image at the service provider 80 or even provide an automatic forwarding of the image to a specified individual. While the images can be automatically analyzed for such information, the user can also specify that a particular icon 202 be associated with a particular image.
(Spec. 13, l. 21-Spec. 14, l. 4).

The Capps Reference

2. Capps teaches an embodiment where a scanning module looks for an image embedded within an electronic document and then performs conventional image recognition techniques on the image to identify the characteristics of a person or persons represented by the photograph. (p. 6, ¶[0052]).
3. Capps teaches an embodiment where graphical data representing a person is automatically compared to information

contained in at least one electronic database for automatically identifying the person. (p. 6, ¶[0053]).

4. Capps teaches an embodiment where data associated with a person is represented by, e.g., an e-mail address (*Id.*), and also that communications can be initiated by “automatically addressing an email message.” (p. 1, ¶[0004]).

The Lloyd-Jones Reference

5. Lloyd-Jones teaches icons with e-mail addresses associated with the icons (p. 4, ¶ [0039]).
6. Lloyd-Jones teaches that metadata (associated with an icon) that describes a person’s name and e-mail address is stored in an association list when the icon is selected. (*Id.*).
7. Lloyd-Jones teaches that if a user wishes to e-mail a number of image files to another person, the “e-mail application can search through the association lists and send all of the images that have [for example,] the metadata ‘Jenny’ associated with them using Jenny’s e-mail address.” (*Id.*).
8. Lloyd-Jones teaches “[in] a further example, if several of the lists have been tagged as ‘like to send’ . . . then the e-mail application can select those images and e-mail them to the address of the person indicated by the metadata included in the association lists associated with those images.” (*Id.*).

The Goldberg Reference

9. Goldberg teaches facial recognition IDs that are computed for facial representations within images (p. 11, ¶ [0142]).
10. Goldberg teaches facial recognition IDs are compared and matched (p. 11, ¶ [0144]).

ANALYSIS

ISSUE 1

Combinability under § 103

We decide the threshold question of whether Appellants have shown that the Examiner erred in combining the cited references.

Appellants contend that the Examiner has improperly combined the references because “Goldberg fails to provide any suggestion to implement or otherwise be combined with an apparatus for annotating an image as described in Lloyd-Jones.” (App. Br. 8). Appellants further contend that “Lloyd-Jones fails to provide any suggestion to implement or otherwise be combined with a system for recognizing a patron’s face as described in Goldberg. (*Id.*).

We begin our analysis by noting that the presence or absence of a reason “to combine references in an obviousness determination is a pure question of fact.” *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 1000 (Fed. Cir. 1999)). Here, we find Appellants’ arguments against combinability are grounded on an erroneous premise that a teaching or suggestion to combine the references is required and/or must be found in the references themselves. To the contrary, the Supreme Court has stated that “[t]he obviousness analysis cannot be

confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way." *KSR*, 550 U.S. at 419.

Moreover, Appellants have not provided any evidence to show that analyzing digital media files (such as digital photographs) to determine if an image portion matches some form of image content identifier for purposes of image forwarding would have entailed anything more than a mere rearrangement of familiar elements to achieve a predictable result, or would have been "uniquely challenging or difficult for one of ordinary skill in the art." *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 417).

For at least these reasons, we find Appellants have not shown that the Examiner erred in combining the cited references.

ISSUE 2

We decide the question of whether Appellants have shown that the combination of Capps, Lloyd-Jones, and Goldberg teaches or would have suggested the argued limitations of automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier, said image content identifier having an associated electronic address of a second party. (*See* representative claim 4).

At the outset, we observe that Appellants contend in the Brief that each of the cited references considered alone fails to teach all of the

aforementioned limitations. (See “*Limitations under § 103*” Appellants’ arguments, *supra*; see also App. Br. 5, 7). However, we note that the proper test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 414, 425 (CCPA 1981); *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991). Moreover, we note that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Here, for the reasons that follow, we agree with the Examiner that the cited combination of references teaches or suggests the limitations argued by Appellants.

We begin our analysis by focusing on the scope of the disputed claim term “image content identifier.” During prosecution, “the PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)).

When we look to Appellants’ Specification for *context*, we find the claimed “image content identifier” is broadly described, as follows: “For example, an image icon 202, such as illustrated in FIG. 10b can be used as a content identifier to first identify content of images forwarded to the service provider 80. In the embodiment illustrated, the image icon 202 is in the form of the face of an individual taken from image 206 of FIG. 10a.” (FF 1).

Thus, consistent with Appellants’ Specification, we broadly but reasonably construe the recited “image content identifier” as *any* identifier (including image icons) that identifies *any* image content in *any* manner. Moreover, we conclude that the broad language of representative claim 4 does not require “an associated electronic address” to be an integral part of the “image content identifier.” Instead, we conclude that this portion of

Appellants' claim is fully met by a teaching or suggestion of *any* form of association between an "image content identifier" and an electronic address (which would, e.g., include associated e-mail addresses).

Given this broad but reasonable construction, we find the evidence before us strongly supports the Examiner's position as articulated in the responsive arguments section of the Answer. (pp. 11-15). We also particularly note that Appellants have not rebutted the Examiner's responsive arguments by filing a Reply Brief. "Silence implies assent." *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 572 (1985).

Here, we find Capps teaches automatically analyzing a digital image media file (at a first party) for determining if a portion of said at least one digital image file matches an image content identifier, because Capps teaches that graphical data representing a person (i.e., a digital image media file) is automatically compared to information (i.e., image content identifier) contained in at least one electronic database for automatically identifying the person (FF 3). We additionally find Capps at least suggests the additional argued limitations of "said image content identifier having an associated electronic address of a second party," because Capps teaches an embodiment where data associated with a person is represented by an e-mail address (i.e., an electronic address), and also that communications can be initiated by "automatically addressing an email message." (FF 4).

Thus, we find Capps teaches or at least suggests the specific limitations argued by Appellants. We find the remaining references essentially serve to buttress the Examiner's core findings regarding Capps.

Regarding the other references relied on by the Examiner, we find Lloyd-Jones' teaching of icons having associated e-mail addresses (FF 5) is

strongly suggestive of the claimed “image content identifier” (as described in Appellants’ Specification as “image icon 202, such as illustrated in FIG. 10b [that] can be used as a content identifier to first identify [the] content of images forwarded to the service provider.”) (FF 1). We also find that Lloyd-Jones teaches or suggests the automatic digital image forwarding feature of Appellants’ representative claim 4¹ (FF 7-8). Lastly, we find Goldberg teaches facial recognition IDs (i.e., yet another teaching of the claimed “image content identifier”) that are computed for facial representations within images that are further compared and matched (FF 9-10). Thus, contrary to Appellants’ arguments, we find the totality of the evidence before us strongly supports the Examiner’s legal conclusion that the combination of Capps, Lloyd-Jones, and Goldberg would have rendered Appellants’ claimed invention obvious to an artisan at the time of the invention.

For at least the aforementioned reasons, we find Appellants have not sustained the requisite burden on appeal of providing arguments or evidence persuasive of error in the Examiner’s rejection of claims 4, 7, 10, 12, 21, 22, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Capps, Lloyd-Jones, and Goldberg.

¹ As pointed out by the Examiner (Ans. 13), broadly providing an automatic way to replace a manual activity, which accomplishes the same result, is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95 (CCPA 1958); *Leapfrog*, 485 F.3d at 1161 (“Applying modern electronics to older mechanical devices has been commonplace in recent years.”). An improved product in the art is obvious if that “product [is] not [one] of innovation but of ordinary skill and common sense.” *KSR*, 550 U.S. at 421.

Claim 11

Regarding dependent claim 11, Appellants contend that:

“[i]t is submitted that further consideration of claim rejections under 35 USC 103(a) upon the citing of the fourth applied prior art reference to Davis is moot, inasmuch as the combination of Capps, Goldberg, Lloyd-Jones and Davis still lack any teaching, disclosure, or suggestion concerning a content identifier having an associated address of a second party as previously discussed.” (App. Br. 8).

Thus, Appellants’ argument for the patentability of claim 11 is premised upon a limitation that we have addressed *supra*. Here, we conclude that nothing in Appellants’ claim 11 (or independent claim 10 from which it depends) requires “an associated electronic address” to be an integral part of the “image content identifier.” Instead, we conclude that the breadth of the claim language is met by *any* form of association between an “image content identifier” and an electronic address, such as an e-mail address. (*See* FF 4-8). Therefore, we find Appellants have not sustained the requisite burden on appeal of providing arguments or evidence persuasive of error in the Examiner’s rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Capps, Lloyd-Jones, Goldberg, and Davis.

CONCLUSIONS

Based on the findings of facts and analysis above:

Appellants have not shown that the Examiner erred in combining the cited references.

Appellants have not shown the Examiner erred in finding that the combination of Capps, Lloyd-Jones, and Goldberg teaches or would have suggested the argued limitations of automatically analyzing a digital image media file at a first party for determining if a portion of said at least one digital image file matches an image content identifier, said image content identifier having an associated electronic address of a second party.

DECISION

We affirm the Examiner's rejection of claims 4, 7, 10, 12, 21, 22, 29, and 30 under 35 U.S.C. § 103(a) as unpatentable over the combination of Capps, Lloyd-Jones, and Goldberg.

We affirm the Examiner's rejection of claim 11 under 35 U.S.C. § 103(a) as unpatentable over the combination of Capps, Lloyd-Jones, Goldberg, and Davis.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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